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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	**ATTENTION: The Office of the Deputy Commissioner for Patent Examination Policy**
Murakawa et al.	
Serial No. 07/402,450	Examiner: A. Marschel
Filed: September 1, 1989	Group Art Unit: 1631
For: METHOD FOR AMPLIFICATION AND DETECTION OF RNA SEQUENCES	

PETITION TO THE COMMISSIONER UNDER 37 CFR § 1.181(a)(3)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.181(a)(3), Petitioner hereby petitions the Commissioner to invoke his supervisory authority to review a delay in declaring an interference involving the above-captioned patent application. Petitioner, City of Hope, is a non-profit medical center and biomedical research institution and is the assignee of this patent application.

I. Point to be Reviewed

Whether the United States Patent and Trademark Office is unreasonably delaying declaring an interference between the above-captioned application and U.S. Patent 5,476,774.

II. Action Requested

Petitioner respectfully requests that the Commissioner 1) determine that the declaration of an interference for the above-captioned application is unreasonably delayed, and 2) direct officials of appropriate authority promptly to declare an interference between the above-captioned application and U.S. Patent 5,476,774 (hereinafter referred to as the '774 patent).

III. Statement of Facts

1. The above-captioned application was filed on September 1, 1989.

2. Following a remand from an appeal of an examiner's rejection to the Board of Patent Appeals and Interferences, Nearly six years ago, on December 18, 1996, Applicants amended their claims and filed a request pursuant to 37 C.F.R. § 1.607 for interference with the '774 patent. Afterwards, Petitioner made several written and telephonic inquiries concerning the status of the application. No Office Action issued for more than three years after the request under § 1.607 was filed.

3. On August 30, 2000, an Office Action issued, and the Office therein "regretted that so much time [had] passed ... [and indicated that t]he Examiner will make every effort to expedite prosecution of this application." Paper No. 40, p. 2.

4. Following further prosecution, on May 4, 2001, an Office Action (Paper No. 46) issued suspending ex parte prosecution

pending a potential interference. Several months later, having not received any further communication, Petitioner made further telephonic inquiries to the Office regarding the status of the application and filed a formal status inquiry. Petitioner then received a communication dated January 14, 2002, again indicating that all claims are allowable and suspending ex parte prosecution pending an interference.

5. More than four months after this second notice, having still not received any communication declaring the interference, Petitioner filed another status inquiry on May 31, 2002. Petitioner's counsel received a telephone call from a Patent and Trademark Office employee simply confirming that prosecution was suspended pending declaration of the interference. No written reply to this second status inquiry nor any explanation has been provided for the 16-month delay since the May 4, 2001 communication indicating that the claims were allowable and prosecution was closed pending declaration of the interference. The interference still has not been declared.

IV. Arguments

The delay in declaring an interference for the above-captioned application is unreasonably long. The Patent and Trademark Office apologized two years ago for the long delay in responding to the Petitioner's original request for an interference under 37 C.F.R. § 1.607, yet the interference still

has not been declared. Now, almost six years have passed since Petitioner filed its request for interference.

This extraordinary delay is causing substantial prejudice to Petitioner through lost business opportunities. Petitioner is a non-profit institution that derives operating revenues inter alia by licensing inventions and discoveries made by its scientists. Such losses are real and significant; the invention in the above-captioned application has a substantial commercial value, upon which the Petitioner has been, and remains, unable to capitalize. While the Petitioner has waited for years for the Patent and Trademark Office to declare an interference and to give them the opportunity to prove that they are entitled to priority to the invention disclosed and claimed in their application, the owners of the '774 patent have had nearly seven years of patent protection and market exclusivity. But the owners of the '774 patent also are prejudiced by this delay. As time passes, marshaling the evidence that will be relevant to the interference will be increasingly difficult.

Therefore, Petitioner respectfully requests that the Commissioner direct the officials of authority promptly to declare an interference between the above-captioned application and '774 patent.

If a fee is required for this petition, please charge deposit account number 02-2135 in the name of Rothwell, Figg, Ernst & Manbeck.

Respectfully submitted,

By Vincent M. DeLuca (Reg. No. 32,408)
for

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